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EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/608,777

Applicant(s)

GROSS ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-17,19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-17,19 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to the following communications: RCE and Request for Reconsideration (hereinafter the Request) filed 11/3/2006. Declaration under 37 CFR 1.132 filed 9/4/2006, entered 11/3/2006.
2. Please note that Examiner Michael Botts is no longer examining in Art Unit 2176. The new examiner of record for this case is William Bashore. Please update future correspondence accordingly.
3. Claims 1-4, 6-17, 19, and 21-23 currently pending. Claims 1, and 10 are independent.
4. Claims 1-4, 6-17, 19, and 21-23 are rejected.

Continued Examination Under 37 CFR 1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/3/2006 has been entered.

Response to Declaration under 37 CFR 1.132

6. The Affidavit under 37 CFR 1.132 filed/entered 11/3/2006 is insufficient to overcome the rejection of the pending claims based upon the instant rejections as set forth in the last Office action because of the following.

Initially, it is noted that the cited prior art, Rifkin and Engle, are both prior art under 35 U.S.C. 102(b), and, as such, secondary evidence of commercial success will be insufficient to overcome the statutory bar. Nevertheless, an analysis of said declaration is presented below.

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The examiner respectfully notes that Applicant has failed to establish a clear nexus between the evidence of secondary considerations and the merits of the claimed invention, for at least the following reasons:

Paragraphs 1 and 2 of the declaration are directed to the credentials of Anne Lindsay Fetter, PhD, said credentials respectfully acknowledged.

Paragraph 3 of the declaration acknowledges that Applicant's claimed invention covers the product Blank Slate™ Board Book Kits, and that said product will be used to seek research funding.

Paragraph 4 declares that Dr. Fetter has not been exposed to such a customized book (Applicant's invention), and that Dr. Fetter is unaware of anything on the market or in development that has the benefits of Blank Slate™ Books. Paragraph 4 additionally purports that Applicant's invention is a significant benefit to children, including benefits of flexibility, instant book production, durability, customization and personalization.

However, based upon the above evidence, the purported benefits do not, in itself, indicate evidence of success, since the description of benefits are merely opinions, rather than evidence of success. The declaration offers no evidence that Blank Slate™ Books has actually been successful in improving a child's communication abilities. Indeed, Dr. Fetter's attempt to demonstrate to the NCLB the efficacy of Blank Slate™ Board Book Kits pursuant to funding (paragraph 3) implies that the efficacy (or desired effect) of Blank Slate™ Books has yet to be proven.

Regarding separate declaration of Carol Bell, the credentials of Carol Bell set forth in paragraph 1 is respectfully acknowledged.

Ms. Bell states in paragraph 5 that the package (the claimed product) is especially important to young children who would benefit accordingly. This recitation is merely an opinion, and not evidence of success.

In view of the strength of the cited art of record applied to the instant rejections, and Applicant's failure to establish a clear nexus between the evidence and the merits of the claimed invention, the

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examiner has determined that Applicant's declaration does not overcome the instant rejection of the pending claims.

Claims Rejection – 35 U.S.C. 112, Second Paragraph

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 6-17, 19, and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 9, and 10 recited the limitation “to create a story.” Claims 2-4, 6-8, 21, and 22, inherit the rejection by their dependence on claims 1. Claims 11-17, 19, and 23, inherit the rejection by their dependence on claims 10.

The term “story” is not expressly defined and, as disclosed and as used in the claims, may vary in definition from a story in the mind of the user to a story written out so that it may be read by anyone. The metes and bounds of the term “story” are indefinite.

Claims 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 21 and 23 recite the limitation “a young child.” Claim 22 inherits the rejection by its dependence from claim 22.

The term “young child” is not expressly defined and, as disclosed and as used in the claims, may vary in definition from one age to another. The metes and bounds of the term “young child” are indefinite.

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Claims Rejection – 35 U.S.C. 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1, 2, 5-12, 15-17, 19, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rifkin (U.S. Patent 6,116,906, filed in 1998 [hereinafter “Rifkin”]), in view of Engel (U.S. Patent 4,714,275, filed in 1986 [hereinafter “Engel”]), wherein Rifkin recites that it was well known in the art at the time of the Rifkin invention of printing user selected designs onto adhesive paper to be used like conventional stickers, and Engel recites that the it was well known in the art at the time of the Engel invention to mount stickers in albums. Both Rifkin and Engel predate the earliest effective filing date of the present application.**

Regarding Independent claim 1, as currently amended, Rifkin in view of Engel teaches:

*A method of self-publishing a customized book by a user, said method comprising:
providing a board book having a plurality of blank pages;
determining creative content for inclusion in said board book, wherein said creative content can be any content, size, color or any combinations thereof;*

(See, Rifkin, col. 1; lines 19-22: “Desktop publishing may be obtained from a number of software providers which is used by the computer to create images at the user’s selection upon the display monitor which are then passed to the printer for a hard copy of the selected design.”)

disposing at the discretion of the user at least a portion of said creative content on an adhesive label, of wherein said at least a portion of said creative content disposed on said

adhesive label is fully customizable; and

(See, Rifkin, col. 1, lines 33-42: “While originally such [computer and printer] systems were used entirely to print images upon paper, in recent years it has been found equally advantageous to print images upon a peel-off sticker bearing media. Thus, sheets of paper shaped in accordance with standard sheet sizes are supported adhesively upon an impervious carrier similar to conventional peel-off stickers. As these sticker sheets are passed through the printer, selected images are placed upon the stickers at the appropriate location by the desktop publishing software.”)

affixing said adhesive label to at least a portion of a page of said plurality of pages of said board book in any formal and/or arrangement desired by the user, wherein said steps of obtaining, said determining, and affixing are performed under the direct control of the user so that said board book is customized in creative content and format and/or arrangement to create a story by the user into the customized book.

(See, Engel, col. 1, lines 16-17: “A popular hobby with children is collecting theme stickers and mounting them in an album.”)

Rifkin teaches that it was known in the art to use of a computer and computer program for the selection of matter to be printed onto an adhesive label page and the use of a printer to produce such labels. Specifically, Rifkin teaches creating customizable stickers on a computer and printing them out and affixing the resulting label or sticker to a toy. Rifkin does not disclose that it was well known to place such stickers in a book.

Engel teaches that affixing stickers to books was well known by those of ordinary skill in the art at the time of the invention. Engel does not specifically teach obtaining creative content for those stickers from a computer and disposing that creative content onto stickers using the computer's printer.

In combination, the teachings of Engel and Rifkin would result in selection of creative material from a computer using software to manipulate such images, disposing that material to an adhesive label using a computer and attached printer, printing out the label, and affixing the label or sticker to a page of

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a book.

One of ordinary skill in the art at the time of the invention facing the problem of creating stickers with a computer in order to place those stickers in a book would be motivated to combine Engel and Rifkin. Both Engel and Rifkin are related patents dealing with uses of adhesive labels relating to children and children's games and it would be obvious to one of ordinary skill in the art to combine the teachings of Rifkin to use a computer to print out stickers with the teachings of Engel recognizing that it was old in the art to place stickers in a book. The resultant combination would be the selection of content from a program on the computer, creation of one or more stickers on the computer, printing out the stickers onto adhesive backed paper sheets, and placing the resultant stickers on one or more pages in a book.)

Regarding **dependent claim 2, as currently amended**, Rifkin in view of Engel teaches:

The method of claim 1, wherein said creative content is selected from the group consisting of a text file, a graphics file, a video file, a web page, an audio file, the user, and any combinations thereof.

(A child collecting stickers and affixing them to the album would be the user. See, Engel, col. 1, lines 16-17.)

Dependent claim 5 is canceled.

Regarding **dependent claim 6, as currently amended**, Rifkin in view of Engel teaches:

The method of claim 1, wherein said determining is accomplished using a software module compatible with said creative content obtained for inclusion in the customized book.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. Specifically, Rifkin recites that it was well known by one of ordinary skill in the art at the time of the invention to use computer software to create

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user customized content to be printed on stickers. See, Rifkin, col. 1, lines 19-24 and 33-36: "Desktop publishing software may be obtained from a number of software providers which is used by the computer to create images at the user's selection upon the display monitor which are then passed to the printer for a hard copy of the selected design. * * * While originally such systems were used entirely to print images upon paper, in recent years it has been found equally advantageous to print images upon a peel-off sticker bearing media.")

Regarding **dependent claim 7, as currently amended**, Rifkin in view of Engel teaches:

The method of claim 1, wherein the customized book has, in total, a plurality of said adhesive labels affixed to a plurality of said pages of said book.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. The additional limitation of affixing a plurality of adhesive labels onto a plurality of pages of a book is not disclosed in the specifications as being inventive. The decision to affix one or many stickers on one or many pages of a book would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made.)

Regarding **dependent claim 8, as currently amended**, Rifkin in view of Engel teaches:

The method of claim 1, wherein the customized book comprises a board book having a plurality of pages of a rigid and durable pressed paper.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. Claim 8 adds to claim 1 the additional limitation that pages of the book be of "rigid and durable pressed paper." The additional limitation of the page thickness is not disclosed in the specifications as being inventive. The disclosure discusses a preference for a certain thickness of paper, not as a part of the invention, but rather as part of the

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workpiece and as an obvious design choice to accommodate rough usage by children. See, page 5, lines 2-4: "The pages of board book 100 may be about 14 millimeters (mils) thick. Other thicknesses of material may be used." The selection of any certain thickness of paper or "durable pressed paper" would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made. A change in size is generally recognized as not being sufficient to patentably distinguish over the prior art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The use of thicker paper in the book for the application of stickers is a mere design consideration.)

Regarding **dependent claim 9, as currently amended**, Rifkin in view of Engel teaches:

The method of claim 1, wherein said book published thereby is a fully personalized and completely customized story.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 1 above. Claim 8 adds to claim 1 the additional limitation that the story be "fully personalized and completely customized." Claim 1 states that the labels must be "customizable." To actually customize the labels would be obvious to one of ordinary skill in the art at the time of the invention and is not, therefore, an inventive limitation.

Applicant has not disclosed that creating a story from customizable labels solves any stated problem or is for any particular purpose. Moreover, it is obvious that customizable labels could and would be customized and used to tell a story. Further, it is common sense that a story told with completely customized labels would be fully personalized. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the customizable labels to tell a completely customized and fully personalize story.)

Regarding **Independent claim 10, as currently amended**, Rifkin in view of Engel teaches:

A system for self-publishing a customized book, said system comprising:

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an input device for determining creative content for inclusion in the customized book,

wherein said creative content can be any content, size, color or any combinations thereof;

(See, Rifkin, Fig. 1, col. 4, lines 5-6 and 11-14: "In operation and in accordance with the present invention, a CD-ROM disk 17 is inserted into a drive input 18." "In the preferred fabrication of the present invention gave, inputs to processor 11 are provided using keyboard 13 and/or mouse 14 to display a selected vehicle image 40 upon display screen 15.")

a processor for controlling the disposing of at least a portion of a representation of said

creative content on an adhesive label, wherein said at least a portion of said creative content

disposed on said adhesive label being fully customizable;

(See, Rifkin, Fig. 1, col. 4, lines 14-16: "Thereafter, inputs are provided to processor 11 which switch the display image upon display screen 15 to a display image 16.")

an output device for performing said disposing; and

(See, Rifkin, Fig. 1, col. 4, lines 26-28: "In accordance with the software on CE-ROM 17, the print operation of printer 20 under control of processor 11 is formatted to correspond to the size and location of various ones of said blank stickers 23 through 26 on blank sheet 22.")

a board book having a plurality of blank pages for affixing said adhesive label with at

least a portion of said creative content disposed thereon to at least a portion of at least one page

of said plurality of pages, wherein said determining, said disposing, and said affixing are

performed under the direct control of said user so that said board book is customized in creative content and formal and/or arrangement to create a story by said user into the customized book.

(The rejection of claim 1 is incorporated herein by this reference. See also, Engel, col. 1, lines 16-17 and 20-22: "A popular hobby with children is collecting theme stickers and mounting them in an album." * *

* "These stickers are mounted in albums which the child keeps and periodically examines.")

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Regarding **dependent claim 11**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said input device obtains said creative content from the group consisting of a text file, a graphics file, a video file, a web page, an audio file, a user, and any combinations thereof.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. Further, see, Engel, col. 1, lines 16-17, and note that a child collecting stickers and affixing them to the album would be the user.)

Regarding **dependent claim 12**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said input device is selected from a group consisting of a mouse, a memory media reader, a memory storage device, a digital camera, a microphone, an optical scanner, and any combinations thereof.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103 rejection claim 10 above. See, Rifkin, Fig. 1 and col. 4, lines 5-6 and 11-14: "In operation and in accordance with the present invention, a CD-ROM disk 17 is inserted into a drive input 18." "In the preferred fabrication of the present invention gave, inputs to processor 11 are provided using keyboard 13 and/or mouse 14 to display a selected vehicle image 40 upon display screen 15.")

Regarding **dependent claim 15, as currently amended**, Rifkin in view of Engel teaches:

The system of claim 10, wherein said user customizes a layout and/or format, and said extent of said adhesive label, according to said user's preferences.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. It is noted that claim 1 reads on preparation of such a label for affixing to a page in a book includes a label or sticker that is drawn or

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colored upon by the user. By common sense, such label is creative content that is customized as to substance, layout, and extent according to the user. Therefore, combining the teachings of Rifkin in view of Engel to obtain a sticker or label, draw or color upon it, and affix it to a page in a book were all well known by one of ordinary skill in the art at the time of the invention.)

Regarding **dependent claim 16, as currently amended**, Rifkin in view of Engel teaches:

The system of claim 15, wherein said customizing is accomplished with the aid of a software module compatible with said creative content obtained for inclusion in said board book.

(The creation, disposition, and affixing of labels containing a user's preferences to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 15 above. See, Rifkin, col. 1, lines 19-23 reciting that the use of software to create and print was known in the art at the time of the Rifkin invention, stating: "Desktop publishing software may be obtained from a number of software providers which is used by the computer to create images at the user's selection upon the display monitor which are then passed to the printer for a hard copy of the selected design.")

Regarding **dependent claim 17, as currently amended**, Rifkin in view of Engel teaches:

The system of claim 10, wherein the customized book published using said system has, in total, a plurality of said adhesive labels affixed to said a plurality of said pages of said book.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. The additional limitation of affixing a plurality of adhesive labels onto a plurality of pages of a book is not disclosed in the specifications as being inventive. The decision to affix one or many stickers on one or many pages of a book would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made.)

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Regarding **dependent claim 19**, as currently amended, Rifkin in view of Engel teaches:

The system of claim 10, wherein said board book and said plurality of pages are of a rigid and durable pressed paper.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. Claim 19 adds to claim 10 the additional limitation that pages of the book be of “rigid and durable pressed paper.” The additional limitation of the page thickness is not disclosed in the specifications as being inventive. The disclosure discusses a preference for a certain thickness of paper, not as a part of the invention, but rather as part of the workpiece and as an obvious design choice to accommodate rough usage by children. See, page 5, lines 2-4: “The pages of board book 100 may be about 14 millimeters (miles) thick. Other thicknesses of material may be used.” The selection of any certain thickness of paper or “durable pressed paper” would have been an obvious design consideration to one of ordinary skill in the art at the time the invention was made. A change in size is generally recognized as not being sufficient to patentably distinguish over the prior art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The use of thicker paper in the book for the application of stickers is a mere design consideration.)

Regarding **dependent claim 21**, Rifkin in view of Engel teaches:

The system of claim 1, wherein the user is a young child.

(The rejection of claim 1 is incorporated herein by this reference. See also, Engel, col. 4, lines 6-21, teaching use of the invention by a child.)

Regarding **dependent claim 23**, Rifkin in view of Engel teaches:

The system of claim 10, wherein the user is a young child.

(The rejection of claim 10 is incorporated herein by this reference. See also, Engel, col. 4, lines 6-21, teaching use of the invention by a child.)

10. **Claims 3, 4, 13, 14, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rifkin in view of Engel as applied by claims 3 and 4 to claim 1 and as applied by claims 13 and 14 to claim 10 above, and in further in view of Smith, "Reproducible Mini Books for Emergent Readers," copyrighted 1998 & 1999 [hereinafter "Smith"].**

Regarding **dependent claim 3**, Rifkin in view of Engel in further view of Smith teaches:

The method of claim 1, further comprising disposing a clear protective covering over said adhesive label affixed to at least a portion of said page, wherein said at least a portion of said creative content disposed on said label is visible through said protective covering.

(See, Smith, page 1: "Enlarge the pictures and text, color them, glue them to construction paper, and laminate them to make a Big Book for Shared Reading . . .")

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. Although Smith does teach using adhesive stickers to affix the pictures to the book pages prior to lamination, it would have been obvious to one of ordinary skill in the art at the time of the invention to enlarge the pictures by photocopying or computer printing onto widely commercially available adhesive paper and to then cut the pictures out and affix the adhesive to the page. The office takes official notice that adhesive backed paper in standard sizes that was could be photocopied and printed on by a computer was commonly commercially available to one of ordinary skill in the art at the time of the invention. One of ordinary skill in the art who was preparing a book, such as that for a child or for scrap booking, would know to combine Rifkin Engel and Smith in that they all deal with low technology preparation of such books. By combining Rifkin and Engel with Smith and the obvious printing to adhesive paper prior to affixing and laminating, the result would have been selection of creative matter to be disposed to a label, disposing such matter to the label and affixing at least a portion of that label or adhesive page to a page in a book,

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and then laminating the book page.)

Regarding **dependent claim 4**, Rifkin in view of Engel in further view of Smith teaches:

The method of claim 3, wherein said protective covering matingly conforms at least to said adhesive label.

(The lamination process is taught as discussed under the 35 U.S.C. 103 rejection claim 3 above. The claimed further limitation by use of an adhesive or heat set clear laminate to “matingly conform” would have been obvious to one of ordinary skill in the art. The office takes official notice that it that lamination of a book page may include use of clear adhesive laminates such as by clear plastic shelf liner, commercial laminates such as for scrapbook use, or other adhesive or heat set laminates, all of which laminates were commonly commercially to one of ordinary skill in the art at the time of the invention. Such choice of laminates over lamination by insertion in a plastic sheet protector or other laminate would be a mere design choice between equivalents known by one of ordinary skill in the art at the time of the invention. Additionally, Substitution of adhesive or heat-set lamination over lamination by insertion is a mere substitution of art recognized equivalents. Further, the office takes official notice that it was well known to one of ordinary skill in the art at the time of the invention that the use of thin adhesive and heat-set laminate sheets would result in a lamination that matingly conformed to anything affixed to a page.)

Regarding **dependent claim 13, as currently amended**, Rifkin in view of Engel in further view of Smith teaches:

The system of claim 10, wherein said output device or said user disposes a clear protective covering over said adhesive label affixed to said at least a portion of one page, wherein said at least a portion of said creative content disposed on said adhesive label is visible through said protective covering.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel

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as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. See, Smith, page 1: “Enlarge the pictures and text, color them, glue them to construction paper, and laminate them to make a Big Book for Shared Reading”

The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. Although Smith does teach using adhesive stickers to affix the pictures to the book pages prior to lamination, it would have been obvious to one of ordinary skill in the art at the time of the invention to enlarge the pictures by photocopying or computer printing onto widely commercially available adhesive paper and to then cut the pictures out and affix the adhesive to the page. The office takes official notice that adhesive backed paper in standard sizes that was could be photocopied and printed on by a computer was commonly commercially available to one of ordinary skill in the art at the time of the invention. One of ordinary skill in the art who was preparing a book, such as that for a child or for scrap booking, would know to combine Rifkin Engel and Smith in that they all deal with low technology preparation of such books. By combining Rifkin and Engel with Smith and the obvious printing to adhesive paper prior to affixing and laminating, the result would have been selection of creative matter to be disposed to a label, disposing such matter to the label and affixing at least a portion of that label or adhesive page to a page in a book, and then laminating the book page.)

Regarding **dependent claim 14**, Rifkin in view of Engel in further view of Smith:

The system of claim 13, wherein said protective covering matingly conforms to at least said adhesive label.

(The creation, disposition, and affixing of labels to a page on a book is taught by Rifkin in view of Engel as discussed under the 35 U.S.C. 103(a) rejection claim 10 above. The lamination process is taught as discussed under the 35 U.S.C. 103 rejection claim 13 above. The claimed further limitation by use of an adhesive or heat set clear laminate to “matingly conform” would have been obvious to one of ordinary

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skill in the art. The Examiner takes official notice that it that lamination of a book page may include use of clear adhesive laminates such as by clear plastic shelf liner, commercial laminates such as for scrapbook use, or other adhesive or heat set laminates, all of which laminates were commonly commercially to one of ordinary skill in the art at the time of the invention. Such choice of laminates over lamination by insertion in a plastic sheet protector or other laminate would be a mere design choice between equivalents known by one of ordinary skill in the art at the time of the invention. Additionally, Substitution of adhesive or heat-set lamination over lamination by insertion is a mere substitution of art recognized equivalents. Further, the office takes official notice that it was well known to one of ordinary skill in the art at the time of the invention that the use of thin adhesive and heat-set laminate sheets would result in a lamination that matingly conformed to anything affixed to a page.)

Independent Claim 20 is canceled.

Regarding **dependent claim 22**, Rifkin in view of Engel and further in view of Smith teaches:

The method of claim 21, wherein each page of said plurality said pages has a paper core coated with a film laminate of about 3 mils on each side of said page for a page thickness of about 12 mils to about 18 mils.

(Rifkin in view of Engle teaches or suggests the limitations of claim 21. Rifkin in view of Engel does not expressly teach or suggest pages with a paper core coated with a film laminate of about 3 mils on each side of the page for an overall page thickness of about 12 mils to about 18 mils.

Smith teaches to: “enlarge the pictures and text, color them, glue them to construction paper, and laminate them to make a Big Book . . .” See, Smith, page 1, bottom paragraph.

The Examiner takes official notice of the fact that gluing pictures and paper containing text to construction paper will result in a page of varying thickness, but also one of substantial thickness that would be in the range of about 6 to 12 mils thick. The Examiner also takes official notice that laminate in

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a wide range of thicknesses, including of about 3 mils thickness, is commonly available on the commercial market for use in laminating paper products. It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined construction paper with objects glued on it with a laminate of about 3 mils thickness on each side to result in a page of about 12 to 18 mils overall thickness for purposes of stiffening and protecting pages in a hand made children's book. Smith teaches the lamination of the pages. The resulting thickness from the lamination is inherent in the thickness of the products used and is inherent in the use of commonly available products when used for the lamination.)

Response to Arguments

11. Applicants' arguments filed 11/3/2006 have been fully and carefully considered, but they are not persuasive.

Applicant argues on page 7 of the Request that the claimed "story" is not indefinite, and that the examiner ignores the clear meaning of "story" as defined in a dictionary. The examiner respectfully disagrees. The examiner is concerned with the metes and bounds of the claimed word in question. It is unclear whether the claimed customized book actually contains a story. Since the scope of what a "story" entails is highly subjective, instant claim 1 does not preclude the interpretation of a book containing any combination of content in any order, analogous to a mental interpretation of abstract art. Accordingly, the metes and bounds of the word in question is not clear.

Applicant essentially argues the same argument with respect to the claimed "young child". It is unclear what the age range of a child (especially a young child) is. The phrase is highly subjective. The examiner attaches a "possible" meaning to the phrase in question for art rejection purposes only.

Regarding rejections of **claims 1, 2, 4, 6, and 9** under 35 U.S.C. 103(a): Applicants argue that Rifkin in view of Engel fails to teach or suggest the limitations of claim 1, and, by their dependency, also fails to teach or suggest the limitations of claims 2, 4, 6, and 9. The Examiner respectfully disagrees.

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First: Applicants argue against the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See, *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second: Applicants argue that Rifkin in view of Engel fail to teach or suggest: “(1) determining creative content for inclusion in said board book.” It is noted that as specified in claim 1, “creative content can be any content, size, color or any combination thereof.” As specified in claim 1, “creative content” is virtually anything. See, Rifkin, col. 3, lines 6-11, teaching printing an image on a sticker.

Third: Applicants argue that Rifkin in view of Engel fail to teach or suggest: “(2) affixing said adhesive label to at least a portion of a page of said plurality of pages of said board book in any format and/or arrangement desired by the user.” It is noted that the limitation recites in pertinent part: “in any format and/or arrangement desired by the user”. The Examiner takes official notice of the fact that placing stickers on a blank page in any format or arrangement desired by the one placing the stickers is well known by one of ordinary skill in the art for purposes of ordering, displaying, or merely disposing the stickers for the enjoyment of peeling stickers from the backing sheet and sticking them to a surface.

Fourth: Applicants argue that Rifkin in view of Engel fail to teach or suggest: “(3) the steps of obtaining, determining, and affixing performed under the direct control of the user so that said board book is customized in creative content and format and/or arrangement to create a story by the user into the customized book.” It is noted that the limitation: “determining . . . so that said board book is customized in creative content and format and/or arrangement to create a story by the user into the customized book”. It is noted that the claim specifies that a person place one or more stickers on a blank page such that it represents a story to that person. The Examiner takes official notice of the fact that placing stickers on a blank page such that it represents meaning such as a story to the person placing the sticker is well known by one of ordinary skill in the art for purposes of representing graphic elements in a story. It is noted that there is no requirement in the claim that the story be expressed anywhere other than the mind of the

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person placing the stickers. It would have been obvious to one of ordinary skill in the art at the time of the invention to place one or more objects on a blank page to tell a story, such as photos in a photo album, or stickers of children's storybook or cartoon characters.

Regarding rejections of **claims 10-17 and 19** under 35 U.S.C. 103(a): Applicants argue that Rifkin in view of Engel fails to teach or suggest the limitations of claim 10, and, by their dependency, also fails to teach or suggest the limitations of claims 11-17 and 19. The Examiner disagrees.

First: Applicants argue against the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See, *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second: Applicants argue that Rifkin in view of Engel fail to teach or suggest: "(1) determining creative content for inclusion in said board book." It is noted that as specified in claim 1, "creative content can be any content, size, color or any combination thereof." As specified in claim 1, "creative content" is virtually anything. See, Rifkin, col. 3, lines 6-11, teaching printing an image on a sticker.

Third: Applicants argue that Rifkin in view of Engel fail to teach or suggest: "(2) affixing said adhesive label to at least a portion of a page of said plurality of pages of said board book in any format and/or arrangement desired by the user." It is noted that the limitation claims in pertinent part: "in any format and/or arrangement desired by the user". The Examiner takes official notice of the fact that placing stickers on a blank page in any format or arrangement desired by the one placing the stickers is well known by one of ordinary skill in the art for purposes of ordering, displaying, or merely disposing the stickers for the enjoyment of peeling stickers from the backing sheet and sticking them to a surface.

Fourth: Applicants argue that Rifkin in view of Engel fail to teach or suggest: "(3) the steps of obtaining, determining, and affixing performed under the direct control of the user so that said board book is customized in creative content and format and/or arrangement to create a story by the user into the customized book."

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It is noted that the limitation claim in pertinent part: "determining . . . so that said board book is customized in creative content and format and/or arrangement to create a story by the user into the customized book". It is noted that the claim specifies that a person place one or more stickers on a blank page such that it represents a story to that person. The Examiner takes official notice of the fact that placing stickers on a blank page such that it represents meaning such as a story to the person placing the sticker is well known by one of ordinary skill in the art for purposes of representing graphic elements in a story. It is noted that there is no requirement in the claim that the story be expressed anywhere other than the mind of the person placing the stickers. It would have been obvious to one of ordinary skill in the art at the time of the invention to place one or more objects on a blank page to tell a story, such as photos in a photo album, or stickers of children's storybook or cartoon characters.

Conclusion

12. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114 (it is noted that Applicant's amendment to claim 1 is grammatical in nature, and therefore not affecting the scope of said claim).

Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 1:00pm - 9:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

February 1, 2007